

Practitioner's Docket No. 2166CON2C

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Golden et al.

Serial No. 09/490,362

Group No.: 2765

Filing Date: January 24, 2000

Examiner: Alan MacDonald

For: INTERACTIVE MARKETING NETWORK AND PROCESS USING ELECTRONIC CERTIFICATES

Assistant Commissioner for Patents

Washington, D.C. 20231

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TRANSMITTAL OF SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
PRIOR TO RECEIPT OF FIRST OFFICE ACTION
PURSUANT TO 37 CFR 1.97(b)

Sir:

Pursuant to 37 CFR 1.97(b) and MPEP § 2280, Applicants submit herewith patents, publications and other information, of which they are aware and which the Examiner is asked to consider in the examination of this application.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 C.F.R. 1.97(g)), an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner. Notice of January 9, 1992, 1135 O.G. 13-25, at 25.

Disclosure Incident to Litigation

Pursuant to MPEP §§ 2001.06(c), 2282, Applicants provide this summary concerning litigation.

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U.S. Patent No. 5,761,648, resulting from parent application U.S. Serial No. 08/507,693, filed July 25, 1995, is currently involved in these six different lawsuits pending in the Northern District of Illinois, Eastern Division, brought by Applicants' assignee, coolsavings.com inc. ("Coolsavings") against alleged infringers of the '648 patent:

- (1) COOLSAVINGS.COM INC., Plaintiff, v. E-CENTIVES, INC. and ZIFF-DAVIS, INC., Defendants. (Case No. 98 C 4924, Judge James M. Rosenbaum, Magistrate Judge Nolan)
- (2) COOLSAVINGS.COM INC., Plaintiff, v. CATALINA MARKETING CORPORATION and SUPERMARKETS ONLINE, INC., Defendants. (Case No. 98 C 6668, Judge John F. Grady, Magistrate Judge Nolan)
- (3) COOLSAVINGS.COM INC., Plaintiff, v. PLANET U, INC. and BRODBECK ENTERPRISES, INC. d/b/a DICK'S SUPERMARKETS, Defendants. (Case No. 98 C 6669, Judge Harry D. Leinenweber, Magistrate Judge Rosemond)¹
- (4) COOLSAVINGS.COM INC., Plaintiff, v. IQ.COMMERCE CORPORATION, Defendant. (Case No. 98 C 7750, Hon. Ronald A. Guzman, Magistrate Judge Bobrick)
- (5) COOLSAVINGS.COM INC., Plaintiff, v. H.O.T! COUPONS, INC., Defendant. (Case No. 98 C 7408, Judge Gottschall, Mag. Judge Keys)
- (6) COOLSAVINGS.COM INC., Plaintiff, v. BRIGHTSTREET.COM, INC., Defendant. (Case No. 99 C 5499, Honorable Judge Norgle, Magistrate Judge Keys)

These infringers have made a variety of arguments in support of their position that the '648 patent is invalid and/or unenforceable due to the commission of inequitable conduct. Rather than trying to summarize those arguments here, Applicants previously attached the pleadings (complaints, answers, counterclaims) for each of these lawsuits at Tab A to the IDS filed in Reexam Control No. 90/005,641 ("the Reexam IDS"). Applicants also attached all relevant portions of all interrogatory responses from each of these defendants in each of these lawsuits, as they relate to the defendants' alleged invalidity and/or unenforceability defenses, as Tab B to the Reexam IDS, and identified as follows:

COOLSAVINGS.COM INC., Plaintiff, v. CATALINA MARKETING CORPORATION and SUPERMARKETS ONLINE, INC., Defendants., (Case No. 98 C 6668)

- DEFENDANT'S FIRST SUPPLEMENTAL RESPONSES TO PLAINTIFF'S INTERROGATORY NOS. 1 AND 3-7 (May 3, 2000)

¹ This Lawsuit recently Settled

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- DEFENDANT'S SECOND SUPPLEMENTAL RESPONSES TO PLAINTIFF'S INTERROGATORY NOS. 3-5 (June 1, 2000)

COOLSAVINGS.COM INC., Plaintiff, v. BRIGHTSTREET.COM, INC., Defendant. (Case No. 99 C 5499)

- DEFENDANT BRIGHTSTREET.COM, INC.'S OBJECTIONS AND RESPONSES TO PLAINTIFF'S FIRST SET OF INTERROGATORIES TO DEFENDANT (NOS. 1-10) (March 20, 2000)

COOLSAVINGS.COM INC., Plaintiff, v. COUPONSURFER.COM, INC., Defendant. (Case No. 98 C 7409)

- DEFENDANT'S RESPONSE TO PLAINTIFF'S FIRST SET OF INTERROGATORIES (April, 1999)

COOLSAVINGS.COM INC., Plaintiff v. EMAGINET, INC., Defendant. (Case No. 98 C 4924)

- EMAGINET'S ANSWERS AND OBJECTIONS TO PLAINTIFF'S SECOND SET OF INTERROGATORIES TO DEFENDANT (NOS. 4-5) (March 22, 1999)

COOLSAVINGS.COM INC., Plaintiff, v. E-CENTIVES, INC. and ZIFF-DAVIS, INC., Defendants. (Case No. 98 C 4924)

- E-CENTIVES'S SUPPLEMENTAL RESPONSE TO PLAINTIFF'S SECOND SET OF INTERROGATORIES TO DEFENDANT (NOS. 4-5) (December 6, 1999)

COOLSAVINGS.COM INC., Plaintiff, v. PLANET U, INC. and BRODBECK ENTERPRISES, INC. d/b/a DICK'S SUPERMARKETS, Defendants. (Case No. 98 C 6669)

- PLANET U'S SUPPLEMENTARY OBJECTIONS AND RESPONSES TO PLAINTIFF'S INTERROGATORIES NUMBERS 1-5 (May 18, 2000)

It is believed that all art brought to applicant's attention in these lawsuits has been disclosed, either previously or in this Supplemental Information Disclosure Statement.

In addition, one defendant in these lawsuits, Catalina, has raised a new matter argument by way of summary judgment. The three summary judgment briefs (opening, response, reply) and all exhibits were also previously attached at Tab C to the Reexam IDS.

Another defendant in these lawsuits, Brightstreet, has advised Coolsavings that it owns a pending

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patent application in which it has submitted for examination the same claims recited in the '648 patent which are now under reexamination in this proceeding. Coolsavings does not know the serial number or filing date of this Brightstreet application.

Finally, the same party, Catalina (a defendant in litigation involving the '648 patent with Coolsavings) has filed a second request for reexamination of the '648 patent, Reexam Control No. 90/005,773, filed July 17, 2000.

Applicants are concerned that one or more of the defendants will attempt to raise inequitable conduct defenses based on a perceived failure to disclose information; thus, Applicants request the Examiner's assistance and guidance to ensure a full and complete disclosure consistent with the rules and MPEP regulations.

Here is a list of patents and publications, copies of which were previously provided in co-pending Reexam Control No. 90/005,641 (reexam request granted May 2, 2000), or in one of the following co-pending predecessor applications to the instant application, including:

- 1) Serial No. 08/507,693 filed July 25, 1995 which issued as Patent No. 5,761,648 on June 2, 1998
- 2) Serial No. 09/073,334 filed May 6, 1998 (now abandoned)
- 3) Serial No. 09/290,441 filed April 13, 1999 (now abandoned)
- 4) Serial No. 09/484,290 filed January 18, 2000
- 5) Serial No. 09/490,362 filed January 24, 2000

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
2,995,727	Quade et al.	08/1961
3,316,536	Andrews et al.	04/1967
3,465,289	R.L. Klein	09/02/69
3,505,646	Affel	04/07/70
3,606,688	J. Zawels et al.	09/21/71
3,777,410	Robinson	12/11/73

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS CONTINUED

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
3,889,062	Epstein	06/10/75
3,899,775	Larsen	08/12/75
3,959,624	Kaslow	05/22/76
4,004,354	Yamauchi	01/25/77
4,012,132	Lazarus	03/15/77
4,014,004	Fuller	03/22/77
4,044,380	Justice et al.	08/23/77
4,071,697	Bushnell et al.	01/31/78
4,071,740	Gogulski	01/31/78
4,141,078	Bridges, Jr. et al.	02/20/79
4,166,540	Marshall	09/04/79
4,186,438	Benson et al.	01/29/80
4,208,652	Marshall	06/17/80
B1 4,210,961	Whitlow et al.	10/01/96
4,245,468	Fondacci	01/20/81
4,247,759	Yuris et al.	01/27/81
4,264,924	Freeman	04/28/81
4,268,744	McGeary	05/19/81
4,271,351	Bloodworth	06/02/81
4,290,688	Call	09/22/81
4,331,973	Eskin et al.	05/25/82
4,331,974	Cogswell et al.	05/25/82
4,355,372	Johnson et al.	10/19/82
4,359,631	Lockwood et al.	11/16/82
4,373,133	Clyne et al.	02/08/83
4,396,985	Ohara	08/02/83
4,404,589	Wright, Jr.	09/13/83
4,412,631	Haker	11/01/83

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS CONTINUED

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
4,449,186	Kelly et al.	05/15/84
4,451,701	Bendig	05/29/84
4,458,320	Sutton	07/03/84
4,484,302	Cason et al.	11/20/84
4,484,328	Schlafly	11/20/84
4,500,880	Gomersall et al.	02/19/85
4,546,382	McKenna et al.	10/08/85
4,554,446	Murphy et al.	11/19/85
4,567,359	Lockwood	01/28/86
4,572,877	Roberts et al.	06/19/86
4,573,072	Freeman	02/25/86
4,588,881	Pejas et al.	05/13/86
4,592,546	Fascenda et al.	06/03/86
4,593,904	Graves	06/10/86
4,597,046	Musmanno et al.	06/24/86
4,602,279	Freeman	07/22/86
4,603,232	Kurland et al.	07/29/86
4,608,601	Schreck et al.	08/26/86
4,625,275	Smith	11/25/86
4,626,844	Mann et al.	12/02/86
4,630,108	Gomersall	12/16/86
4,635,132	Nakamura	01/06/87
4,636,950	Caswell et al.	01/13/87
4,642,767	Lerner	02/10/87
4,658,290	McKenna et al.	04/14/87
4,669,730	Small	06/02/87
4,670,853	Stepien	06/02/87
4,674,041	Lemon et al.	06/16/87

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS CONTINUED

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
4,699,532	Smith	10/13/87
4,703,423	Bado et al.	10/27/87
4,713,761	Sharpe et al.	12/15/87
4,723,212	Mindrum et al.	02/02/88
4,733,301	Wright, Jr.	03/22/88
4,734,858	Schlafly	03/29/88
4,745,468	Von Kohorn	05/19/88
4,748,684	Wright, Jr.	05/31/88
4,750,151	Baus	06/07/88
4,752,675	Zetmeir	06/19/88
4,774,663	Musmanno et al.	09/27/88
4,775,935	Yourick	10/04/88
4,791,281	Johnsen et al.	12/13/88
4,792,018	Humble et al.	12/20/88
4,794,530	Yukiura et al.	12/27/88
4,807,031	Broughton et al.	02/21/89
4,812,986	Smith	03/14/89
4,815,741	Small	03/28/89
4,816,904	McKenna et al.	03/28/89
4,821,101	Short	04/11/89
4,825,045	Humble	04/25/89
4,833,308	Humble	05/23/89
4,847,690	Perkins	07/11/89
4,853,882	Marshall	08/01/89
4,858,000	Lu	08/15/89
4,870,596	Smith	09/26/89
4,872,113	Dinerstein	10/19/89
4,876,592	Von Kohorn	10/19/89

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS CONTINUED

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
4,882,675	Nichtberger et al.	11/1989
4,882,724	Vela et al.	11/21/89
4,890,321	Seth-Smith et al.	12/26/89
4,894,784	Smith	01/16/90
4,896,791	Smith	01/30/90
4,908,761	Tai	03/13/90
4,910,672	Off et al.	03/20/90
4,922,522	Scanlon	05/01/90
4,926,255	Von Kohorn	05/1990
4,926,256	Nanba	05/15/90
4,929,819	Collins, Jr.	05/29/90
4,930,011	Kiewit	05/1990
4,937,742	Marshall	06/26/90
4,937,853	Brule et al.	06/26/90
4,949,256	Humble	08/1990
4,959,686	Spallone et al.	09/25/90
4,959,783	Scott et al.	09/25/90
4,965,437	Nagai	10/23/90
4,972,504	Daniel, Jr. et al.	11/20/90
4,973,952	Malec et al.	11/27/90
4,974,170	Bouve et al.	11/27/90
4,975,951	Bennett	12/04/90
4,982,337	Burr et al.	01/01/91
4,982,346	Girouard et al.	01/01/91
4,984,156	Mekata	01/08/91
4,996,705	Entenmann et al.	02/26/91
5,003,384	Durden et al.	03/26/91
5,003,472	Perrill et al.	03/26/91

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS CONTINUED

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
5,010,485	Bigari	04/23/91
5,014,125	Pocock et al.	05/07/91
5,014,212	Smith	05/07/91
5,025,139	Halliburton, Jr.	06/18/91
5,034,807	Von Kohorn	07/19/91
5,039,848	Stoken	08/13/91
5,047,614	Bianco	09/10/91
5,048,833	Lamle	09/17/91
5,056,019	Schultz et al.	10/08/91
5,057,915	Von Kohorn	10/19/91
5,063,610	Alwadish	11/05/91
5,069,453	Koza et al.	12/03/91
5,070,404	Bullock et al.	12/03/91
5,077,607	Johnson et al.	12/31/91
5,083,272	Walker et al.	01/21/92
5,093,718	Hoarty et al.	03/03/92
5,111,196	Hunt	05/05/92
5,111,927	Schulze, Jr.	05/12/92
5,117,355	McCarthy	05/26/92
5,119,295	Kapur	06/02/92
5,128,520	Rando et al.	07/07/92
5,128,752	Von Kohorn	07/07/92
5,155,591	Wachob	10/13/92
5,158,310	Tannehill et al.	10/27/92
5,159,549	Hallman, Jr. et al.	10/27/92
5,173,594	McClure	12/22/92
5,173,851	Off et al.	12/22/92
5,176,224	Spector	01/05/93

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS CONTINUED

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
5,185,695	Pruchnicki	02/09/93
5,192,854	Counts	03/09/93
5,193,056	Boes	03/09/93
5,198,644	Pfeiffer	03/30/93
5,202,826	McCarthy	04/13/93
5,214,792	Alwadish	05/25/93
5,227,874	Von Kohorn	07/1993
5,231,568	Cohen et al.	07/27/93
5,235,509	Mueller et al.	08/10/93
5,237,157	Kaplan	08/17/93
5,237,499	Garback	08/1993
5,237,620	Deaton	08/07/93
5,239,480	Huegel	08/24/93
5,243,174	Veeneman et al.	09/07/93
5,245,533	Marshall	09/1993
5,249,044	Von Kohorn	09/1993
5,250,789	Johnsen	10/05/93
5,256,863	Ferguson et al.	10/26/93
5,260,778	Kauffman et al.	11/1993
5,278,752	Narita et al.	01/11/94
5,283,734	Von Kohorn	02/1994
5,285,278	Holman	02/08/94
5,287,181	Holman	02/1994
5,287,266	Malec et al.	02/15/94
5,287,268	McCarthy	02/15/94
5,295,064	Malec et al.	03/15/94
5,305,195	Murphy	04/19/94
5,305,196	Deaton et al.	04/19/94

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS CONTINUED

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
5,305,197	Axler et al.	04/19/94
5,310,997	Roach et al.	05/10/94
5,319,455	Hoarty et al.	06/07/94
5,343,239	Lappington et al.	08/30/94
5,353,218	De Lapa et al.	10/1994
5,368,129	Von Kohorn	11/1994
5,373,440	Cohen et al.	12/13/94
5,380,991	Valencia et al.	01/10/95
5,382,970	Kiefl	01/17/95
5,389,964	Oberle et al.	02/14/95
5,401,946	Weinblatt	03/28/95
5,404,161	Douglass et al.	04/04/95
5,412,191	Baitz et al.	05/02/95
5,412,416	Nemirofsky	05/02/95
5,420,606	Begum et al.	05/30/95
5,430,644	Deaton et al.	07/04/95
5,438,355	Palmer	08/01/95
5,446,919	Wilkins	08/1995
5,448,471	Deaton et al.	09/05/95
5,459,306	Stein et al.	10/1995
5,483,049	Schulze, Jr.	01/09/96
5,488,423	Walkingshaw et al.	01/30/96
5,490,060	Malec et al.	02/06/96
5,491,838	Takahisa et al.	02/13/96
5,500,514	Veeneman et al.	03/19/96
5,500,681	Jones	03/1996
5,502,636	Clarke	03/26/96
5,504,519	Remillard	04/02/96

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS CONTINUED

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
5,504,675	Cragun et al.	04/1996
5,508,731	Kohorn (VonKohorn)	04/16/96
5,510,859	Douglass et al.	04/23/96
5,513,109	Fujishima	04/30/96
5,515,098	Carles	05/07/96
5,515,270	Weinblatt	05/07/96
5,523,794	Mankovitz et al.	06/04/96
5,528,490	Hill	06/18/96
5,535,118	Chumbly	07/09/96
5,546,523	Gatto	08/13/96
5,550,734	Tarter et al.	08/27/96
5,557,518	Rosen	09/17/96
5,557,721	Fite et al.	09/17/96
5,564,073	Takahisa	10/08/96
5,570,465	Tsakanikas	10/29/96
5,577,266	Takahisa et al.	11/19/96
5,579,537	Takahisa	11/26/96
5,581,764	Fitzgerald et al.	12/03/96
5,584,025	Keithley et al.	12/10/96
5,592,378	Cameron et al.	01/07/97
5,592,379	Finfrock et al.	01/1997
5,592,560	Deaton et al.	01/07/97
5,594,493	Nemirofsky	01/14/97
5,604,542	Dedrick	02/18/97
5,612,527	Ovadia	03/18/97
5,612,730	Lewis	03/18/97
5,612,868	Off et al.	03/18/97
5,621,812	Deaton et al.	04/15/97

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS CONTINUED

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
5,634,101	Blau	05/27/97
5,636,346	Saxe	06/1997
5,638,457	Deaton et al.	06/10/97
5,642,484	Harrison III et al.	06/1997
5,642,485	Deaton et al.	06/24/97
5,644,723	Deaton et al.	07/1997
5,647,677	Smith	07/15/97
5,649,114	Deaton et al.	07/15/97
5,652,421	Veeneman et al.	07/29/97
5,659,469	Deaton et al.	08/19/97
5,664,110	Green et al.	09/02/97
5,675,662	Deaton et al.	10/07/97
5,679,938	Templeton et al.	10/21/97
5,687,322	Deaton et al.	11/11/97
5,697,844	Von Kohorn	12/16/97
5,701,252	Facchin et al.	12/23/97
5,708,780	Levergood et al.	01/13/98
5,708,782	Larson et al.	01/1998
5,710,886	Christensen et al.	01/20/98
5,710,887	Chelliah et al.	01/20/98
5,713,795	Von Kohorn	02/1998
5,715,314	Payne et al.	02/03/98
5,724,424	Gifford	03/03/98
5,724,521	Dedrick	03/1998
5,727,153	Powell	03/10/98
5,734,823	Saigh et al.	03/31/98
5,734,838	Robinson et al.	03/31/98
5,754,938	Herz et al.	05/1998

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS CONTINUED

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
5,758,257	Herz et al.	05/1998
5,759,101	Von Kohorn	06/02/98
5,761,648	Golden et al.	06/02/98
5,774,170	Hite et al.	06/30/98
5,774,868	Cragun et al.	06/30/98
5,774,869	Toader	06/30/98
5,774,870	Storey	06/30/98
5,791,991	Small	08/1998
5,793,497	Funk	08/11/98
5,793,849	Young et al.	08/11/98
5,794,207	Walker et al.	08/11/98
5,794,210	Goldhaber et al.	08/11/98
5,797,127	Walker et al.	08/18/98
5,806,044	Powell	09/08/98
5,812,668	Weber	09/22/98
5,815,657	Williams et al.	09/29/98
5,822,735	De Lapa et al.	10/13/98
5,832,457	O'Brien et al.	11/03/98
5,832,458	Jones	11/03/98
5,837,117	Cameron et al.	11/17/98
5,838,906	Doyle et al.	11/17/98
5,845,259	West et al.	12/01/98
5,848,396	Small	12/1998
5,850,446	Berger et al.	12/15/98
5,855,007	Jovicic et al.	12/29/98
5,855,008	Goldhaber et al.	12/29/98
5,857,175	Day et al.	01/05/99
5,862,325	Reed et al.	01/19/99

PREVIOUSLY SUBMITTED U.S. PATENT DOCUMENTS CONTINUED

<u>PATENT NO.</u>	<u>INVENTOR</u>	<u>ISSUE DATE</u>
5,870,724	Lawlor et al.	02/09/99
5,880,769	Nemirofsky et al.	03/1999
5,884,277	Khosla	03/1999
5,889,863	Weber	03/30/99
5,892,827	Beach et al.	04/06/99
5,893,075	Plainfield et al.	04/1999
5,903,874	Leonard et al.	05/11/99
5,905,246	Fajkowski	05/18/99
5,907,830	Engel et al.	05/25/99
5,907,831	Lotvin et al.	05/25/99
5,909,673	Gregory	06/01/99
5,915,007	Klapka	06/22/99
5,915,243	Smolen	06/22/99
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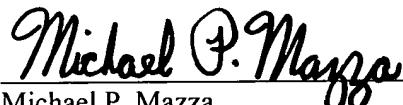
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If the Examiner would like to receive further copies of any of this art, the examiner is asked to contact the undersigned.

Respectfully submitted,



Michael P. Mazza
Registration No. 34,092
NIRO, SCAVONE, HALLER & NIRO
181 West Madison Street, Suite 4600
Chicago, Illinois 60602
(312) 236-0733

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